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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------------|------------------------|
| 10/667,877 | 09/22/2003 | David Boyd Melvin | MELV / 27US | 1155 |
| 26875 7590 12/10/2007 WOOD, HERRON & EVANS, LLP 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202 | | | EXAMINER BLANCO, JAVIER G | |
| | | | ART UNIT 3774 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/667,877

Applicant(s)

MELVIN, DAVID BOYD

Examiner

Javier G. Blanco

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/9/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 12, 14, 15, 21, 23, and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-11, 13, 16-20 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment of claims 1 and 9 in the reply filed on August 9, 2007 is acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 9-11, 13, 16-20, and 22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lundback (US 4,957,477; cited in Applicant's IDS).

Referring to Figures 2 and 3, Lundback discloses a heart-mounted structure comprising an assistive heart-actuating basal dome structure (jacket 10a) *that assists* actuation of the heart, the dome structure conforms to a general shape of a basal surface (read column 6, lines 10-20) of a ventricular portion (RV, LV) of the heart and is *configured for being coupled* therewith, the dome structure having at least one opening (recesses 16a1, 16a2) formed therein *to surround* a great vessel (aorta, pulmonary artery, etc.) of the heart; and the dome structure, proximate the opening, being *configured to interface* with at least one of an atrial chamber (RA, LA) or the great vessel (aorta, pulmonary artery, etc.) of the heart (see column 5, lines 33-46; column 6, lines 10-20). The dome structure further comprising a cushion (**first interpretation:** inner wall 11; **second interpretation:** material within interspace 13; **third interpretation:** inner wall 11 +

material within interspace 13), which cushion is coextensive and integral with the dome. The connection to tube 14, fasteners 18, and/or outer wall 12 may be broadly interpreted as the generally rigid material. Regarding the separated sections (i.e., claim 22), see column 5, lines 33-46; column 6, lines 10-20.

Note: Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA1959).

“[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

4. Claims 9-11, 13, 16-20, and 22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Grooters (US 5,131,905; cited in Applicant’s IDS).

Referring to Figures 1, 2, 6, and 7, Grooters discloses a heart-mounted structure (10) comprising an assistive heart-actuating basal dome structure (30) *that assists* actuation of the heart, the dome structure conforms to a general shape of a basal surface of a ventricular portion (Figure 6: left ventricle 14, right ventricle 16) of the heart and is *configured for being coupled* therewith, the dome structure having at least one opening formed therein (openings formed by strap/band 48, perimeter strap/band 54, and strap/bands 50 + 52) *to surround* a great vessel (e.g., aorta 22) of the heart; and the dome structure, proximate the opening, being *configured to*

interface with at least one of an atrial chamber (Figure 6: left atrium 18, right atrium 20) or the great vessel (e.g., aorta 22) of the heart.

The dome structure further comprising a cushion (**first interpretation:** inner wall 32; **second interpretation:** material within space 33; **third interpretation:** inner wall 32 + material within space 33), which cushion is coextensive and integral with the dome. The connection to tube 44 and/or perimeter strap/band 54 may be broadly interpreted as the generally rigid material. Regarding the separated sections (i.e., claim 22), see Figures 1, 2, 6, and 7.

Note: Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA1959).

“[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. This application contains claims 1-8, 12, 14, 15, 21, 23, and 24 drawn to an invention nonelected with traverse in the reply filed on October 19, 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (9:00 a.m.-7:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications


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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 4, 2007

Javier G. Blanco

A large, stylized handwritten signature in black ink, consisting of a large 'J' and 'B' intertwined.A handwritten signature in black ink, appearing to read 'D. Willse'.

David H. Willse
Primary Examiner